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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,887	04/16/2001	Paola Lenti	1011-287	4551
7590	02/24/2004		EXAMINER	
James V. Costigan, Esq. HEDMAN & COSTIGAN, P.C. Suite 2003 1185 Avenue of the Americas New York, NY 10036-2646			PIERCE, JEREMY R	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 02/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/835,887	LENTI, PAOLA <i>OB</i>
	Examiner	Art Unit
	Jeremy R. Pierce	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 December 2003.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 20-23 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 20-23 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2003 has been entered.

***Response to Amendment***

2. Applicant's amendment cancels claims 15-19. New claims 20-23 have been added and are now currently pending.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites "including three layer." This minor informality should read "including three layers."

Claims 20 and 23 recite "a thermoformable plastics material central layer having a top face on which a woven or non-woven material top layer is arranged, said top layer is arranged, said top layer comprising a woven and dyed wool felt material." This is confusing because twice it is stated that "the top layer is arranged." Additionally, Applicant recites a woven or non-woven material top layer, but then later recites that the top layer comprises a woven and dyed wool felt. Does this mean that the top layer is only woven? How can a non-woven material comprise woven wool felt? Is the top layer actually a two-layer composite comprising both nonwoven and woven material? If so, it is not clear from reading the claim language or specification.

Claims 20 and 23 recite "while being die-cut and hot pressed to provide said top layer with surface marks or projecting and recessed patterns." Claim 21 also recites a similar limitation with regard to the central layer. What type of structure is given to surface marks? What is a surface mark?

Claim 22 recites "a top layer of a woven or non-woven material." However, claim 20 has already previously recited the top layer comprises a woven felt. Is the top layer actually a two-layer composite comprising both nonwoven and woven material? If so, it is not clear from reading the claim language or specification.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1771

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. (U.S. Patent No. 4,263,727) in view of Latzke (U.S. Patent No. 4,887,368) and further in view of Dessaint et al. (U.S. Patent No. 4,295,976).

Bender et al. disclose a web of natural or synthetic fibers that is flame-laminated to closed-cell polyolefin foam (column 1, lines 31-35) without the use of adhesive (column 2, lines 31-33). In a preferred embodiment, closed-cell polyethylene foam is combined with an upper layer of woven cotton fabric and a lower layer of nonwoven nylon (column 2, lines 62-68). The nonwoven nylon fabric layer in the laminate would be suitable for attachment to a male coupling portion of a tearable strip means because nonwoven fabric, in general, couples to male portions of tearable strip means. Although Bender et al. disclose the top layer can be a woven cotton fabric (column 2, line 65), the reference does not disclose it to be a woven wool fabric that is dyed and smear resistant. Latzke discloses that woven wool, as well as woven cotton can be used as a skin compatible layer in a shoe insole (column 7, lines 42-46). It would have been obvious to one having ordinary skill in the art to use woven wool as the top layer in the insole of Bender et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. It would also have been obvious to dye the wool fabric any desired color for use as a shoe insole. However, Latzke does not disclose a smear resistant property in the upper layer. Dessaint et al. disclose that a stain resistant property may be imparted onto textile fabrics, including woven and nonwoven articles of

Art Unit: 1771

cotton and wool (column 7, lines 36-45). It would have been obvious to one having ordinary skill in the art to add a stain-resistant agent to the top layer of Bender et al. in order to improve likelihood of avoiding stains, as taught by Dessaint et al. Although Bender et al. does not disclose the top layer to have surface marks or projecting and recessed patterns, Latzke shows that the insole material is preferably made with recessed areas to better accommodate a foot (see Figures 15 and 16). It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the insole of Bender et al. with recessed areas in order to make the insole more comfortable for the wearer. With regard to claim 21, the recessed areas of the insole would also be present in the central foam layer because that layer is the one that is molded.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. in view of Latzke and Dessaint et al. as set forth above, and further in view of Cohen (U.S. Patent No. 4,187,621).

Bender et al. do not disclose that the shoe insole is die cut with a contour mold. Cohen teaches an insole for shoes where the layers are flame-bonded together and then cut and conformed in contour with various thickness (Claim 1), so Cohen also recognizes the importance of molding with recessed areas and projected areas. It would have been obvious to one having ordinary skill in the art to use the method of forming a shoe insole disclosed by Cohen in the insole of Bender et al. in order to create a shoe insole that better fits the wearer's foot.

***Response to Arguments***

8. Applicant's arguments filed on October 30, 2003 have been fully considered but they are not persuasive.
9. Applicant argues that the layers in the Bender et al. laminate are not provided with impressed surface marks or projecting or recessed portions as required by new claim 20. This new limitation in claim 20 does render the claim outside the scope of Bender et al. alone, but providing such projecting and recessed elements in an insole material is obvious in the art, as set forth in the new rejection above.
10. Applicant argues that the prior art laminates are not suitable for covering floors or walls because the sole laminate does not have strip coupling means. However, the recitation that the laminate of Applicant's invention is used as a modular floor or wall covering is a recitation of an intended use, and is not given patentable weight in a product claim. The claim limitation recites that the bottom layer is suitable for coupling with a male coupling portion of a tearable adhesive strip means. Nonwoven fabrics in general are suitable for coupling with a male coupling portion of a tearable adhesive strip means. So the bottom layer nonwoven fabric provided in Bender et al. meets the claim limitation.
11. Applicant argues that the Latzke laminate comprises metal, and claim 23 excludes the possibility that one layer may be of metal. However, the metal layer of Latzke is not used in the rejection set forth above. The Latzke reference is used to show that wool is a suitable equivalent to cotton for the top layer, and that shoe insoles can be molded with a non-planar shape. Additionally, the transitional phrase "consisting

Art Unit: 1771

essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Even if the metal layer of Latzke were incorporated into the composite of Bender et al., it would have to materially affect the basic and novel characteristics of the claimed invention.

The presence of a metal layer would not meet such a standard.

12. Applicant argues that it is not seen how it would obvious to modify a shoe sole by adding projecting or recessed patterns. However, as shown above in the rejection, such practice is common in the shoe insole art in order to provide an accommodating fit to the wearer's foot.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP

JRP

*Elizabeth M. Cole*  
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Patent Examiner